UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,518	12/28/2001	Peter Thomas Camble	30014514-1	1655

7590 01/31/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER
THAI, TUAN V

ART UNIT	PAPER NUMBER
2186	

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/034,518	CAMBLE ET AL.
	Examiner	Art Unit	
	Tuan V. Thai	2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*23 December 2005*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-30* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *14-21* is/are allowed.

6)☒ Claim(s) *1-8,10-13,22,23 and 25-30* is/are rejected.

7)☐ Claim(s) *9 and 24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/26/05 & 12/23/05*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Part III   DETAILED ACTION

Response to Amendment

1.   This office action is in response to Applicant's communication filed December 23, 2005. This amendment has been entered and carefully considered. Claims 1-13 and 22-30 remain pending in the application. Claims 14-21 are allowed.

2.   Applicant's arguments, see pages 9-12 filed December 23, 2005, with respect to claims 1-8, 10-13 under 35 U.S.C 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of new ground of rejection (different interpretation of the previously applied reference).

3.   Examiner would like to thank Applicant counsel for pointing out the typographical error of claim 8 under 35 U.S.C. 112, second paragraph, it should be read as claim 12 instead. Any inconvenience is SINCERELY regretted.

4.   It should be noted that the application information in the header of the amendment wherein Application No. is being incorrectly referred to as 10/032,923. It should be read as 10/034,518 instead.

Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-8, 10-13, 22-23 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (USPN: 5,455,409); hereinafter Smith.

As per claim 1, Smith discloses a method for securing access to a data medium said method comprises recording a unique identification number (e.g. VOLUME serial number, VOLSER) assigned to each medium (tape cartridge) in at least a portion of a data library is equivalently taught as each tape cartridge is provided with a circuit device and memory operable to store

VOLSER number of the cartridge (e.g. see column 5, line 67

bridging column 6, line 6; column 11, lines 25-28); Smith

discloses utilizing the VOLSER number in order to track the

location of a particular tape in a tape carrier based upon a

match of the VOLSER number; for example, Smith discloses if the

VOLSER numbers do match, a positive instruction is sent to

action block 420, instructing the system to get the aisle, rack,

and position numbers of the particular receptacle out of the 64

byte EEPROM memory in the microcontroller 300 (e.g. see column

24, lines 44-61). Smith does not particularly disclose

commanding at least one selected data transfer element in said

library to only accept media having particular ones of said

identification numbers. It should be noted that by determining

the location of the requested medium (tape) with respect to the

matching of the VOLSER numbers, it's clearly understood that any

transfer element within Smith's system must only accept media

associated with the matching VOLSER in order to avoid

transferring of any unmatched media or unmatched media data to

the host. Accordingly, it would have been obvious to one having

ordinary skill in the art at the time the current invention was

made to implement the data transfer element in the library to

only accept media having matching VOLSER number or matching

identification number as being claimed. In doing so, it would

enhance system reliability; reducing data transferring error by

avoiding reading wrong data in any unmatched media, therefore being advantageous.

As per claim 2, Smith discloses clearing a previous list of allowed identification numbers for each data transfer element is equivalently taught as the EEPROM/or respective memory devices can be programmed/changed/cleared with appropriated VOLSER (e.g. see column 6, lines 58 et seq.; column 8, lines 44 et seq.; column 10, lines 55 et seq.);

As per claim 3, Smith discloses reading the identification numbers (VOLSER number) of media/tape (e.g. see column 14, lines 22-23);

As per claim 4, listing the identification (VOLSER) numbers of media in memory storage of the at least one selected data transfer elements that the selected data transfer elements is to be allowed to access is equivalently taught as displaying/ listing by the display unit 66 for indicating the VOLSER number and tape cartridge location of the requested tape cartridge and the designated tape cartridge drive into which it is to be loaded (e.g. see column 10, lines 45-49);

As per claim 5, entering identification numbers (VOLSER number) of media said at least one selected data transfer elements is allowed to access in memory storage of said at least one selected data transfer elements is taught as programming the respective memory devices associated with each tape with the

VOLSER number of the particular tape and other pertinent

information (e.g. see column 6, lines 59 et seq.);

As per claim 6, reading the identification (VOLSER) number

of said medium/tape during transport of said medium from a

medium storage element slot to one of said data transfer

elements (e.g. see column 6, lines 15-19; column 10, lines 55 et

seq.; column 11, lines 23 et seq.);

As per claim 7; Smith discloses reading said identification

(VOLSER) number of the medium/tape using a data transfer element

receiving said medium (e.g. see column 14, lines 22-23);

As per claim 8, Smith discloses checking memory storage

associated with said at least one selected data transfer element

for said identification number of said medium/tape is

equivalently taught as the host computer interrogates circuitry

within each of the tape carriers to determine whether there is a

match between a requested VOLSER number and the VOLSER numbers

of tapes currently stored in the respective tape carriers in

order to accept or to reject the tape media (e.g. see column 6,

lines 14-19);

As per claims 10 and 11, Smith discloses the identification

number (VOLSER) is encoded in a barcode, disposed on the medium

and wherein the identification (VOLSER) number resides in

cartridge memory of said medium (e.g. see column 14, lines 5 et

seq.).

As per claim 12, Smith further discloses that wherein said

data library is partitioned into a plurality of partitions or

tape cartridges (e.g. see column 8, lines 20-21) and the

recording step comprises reading said identification numbers of

said media in a particular partition (VOLSER of the tape

cartridge is read and encoded when host computer 52 received a

tape cartridge request; e.g. see column 15, lines 14 et seq.);

in addition, Smith also discloses the restricting access of the

selected data transfer elements to the media in a same partition

or tape cartridge as being equivalent to when comparing the

VOLSER number read from a respective receptacle to the requested

VOLSER number that does not match at decision block 418, a

negative output (or restricted access order) is sent along path

411 and 413 (e.g. see column 24, lines 53 et seq.);

As per claim 13, Smith discloses wherein the unique

identification numbers are universally unique (e.g. see column

1, lines 39-43 and lines 60-62);

As per claim 22, Smith discloses a partitioned data library

comprises data storage media (e.g. see figures 1 and 2), each

medium of the media (tape cartridge) having an identification

number (e.g. see column 8, lines 18-21); a plurality of storage

element slots each of said slots adapted to store a medium of

said data storage media (e.g. see figure 2; column 8, lines 33

et seq.; also column 59 et seq.), at least one set of at least

one of said slots assigned to one partition of a plurality of

library partitions is equivalently taught as twenty tape

cartridge slots is assigned for each tape carrier (e.g. see

column 8, lines 63-65); Smith further discloses a plurality of

data transfer elements that are adapted to receive said media

and transfer data to and from said media wherein each of at

least one set of at least one of said data transfer elements

assigned to one of said library partitions as being equivalent

to data transmission means associated with each carrier

receptacle and each tape for updating the memory of each carrier

when a tape is transferred or removed (e.g. see column 6, lines

46 et seq.). Smith discloses utilizing the VOLSER number in

order to track the location of a particular tape in a tape

carrier based upon a match of the VOLSER number; for example,

Smith discloses if the VOLSER numbers do match, a positive

instruction is sent to action block 420, instructing the system

to get the aisle, rack, and position numbers of the particular

receptacle out of the 64 byte EEPROM memory in the

microcontroller 300 (e.g. see column 24, lines 44-61). Smith

does not particularly disclose access to said media by each of

said data transfer elements is restricted to media having

particular ones of said identification numbers. It should be

noted that by determining the location of the requested medium

(tape) with respect to the matching of the VOLSER numbers, it's

clearly understood that any transfer element within Smith's

system must only accept media associated with the matching

VOLSER in order to avoid transferring of any unmatched media or

unmatched media data to the host. Accordingly, it would have

been obvious to one having ordinary skill in the art at the time

the current invention was made to implement the data transfer

element in the library to only accept media having matching

VOLSER number or access to the media by each of the data

transfer elements is restricted to media having particular ones

of the identification numbers as being claimed. In doing so, it

would enhance system reliability; reducing data transferring

error by avoiding reading wrong data in any unmatched media,

therefore being advantageous.

As per claim 23, Smith discloses library controller as being

equivalent to library controller circuit 42 for directing

movement of said media to and from one of said set of slots to

and from one of said sets of data transfer elements assigned to

a same of said partitions (e.g. see figure 6);

As per claim 25, Smith discloses the EEPROM chip for storing

identification numbers VOLSER that data transfer element is

allowed to access (e.g. see column 11, lines 25-28);

As per claim 26, wherein said identification number is

encoded in a barcode disposed on said medium (e.g. see column

14, lines 5 et seq.);

As per claim 27, wherein the identification numbers (VOLSER) reside in cartridge memory of said media (e.g. see column 8, lines 18 et seq.);

As per claim 28, wherein said identification number of said medium is read during transport of said medium from one of said storage element slots to one of said data transfer elements (e.g. see column 6, lines 15-19; column 10, lines 55 et seq.; column 11, lines 23 et seq.);

As per claim 29, Smith discloses the media identification numbers (VOLSER) are read by the data transfer elements (e.g. 14, lines 24 et seq.);

As per claim 30, wherein the unique identification numbers are universally unique (e.g. see column 1, lines 39-43 and lines 60-62);

Allowable subject matter

6.   Claims 9 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. The prior arts of record neither disclose nor teach a medium is rejected from one of the data transfer element in response to the identification number not being one of the particular ones of the identification numbers.

7.   With respect to the remark, Applicant's counsel agrue that

(a) the office action does not address the preamble of claim 1

other than to generally state "Smith discloses a method for

securing access to a data medium" (amendment's page 10, last

paragraph), and (b) Examiner seems to be relying on impermissible

hindsight in order to piece together the elements of the claims

based on knowledge gleaned from Applicant's disclosure

(amendment's page 15, third paragraph); and (c) Other arguments

have been considered, however they are moot in view of the new

ground of rejection and objection.

   With respect to (a); in response to Applicant's argument,

the recitation "A method for securing access to a data medium"

has not been patentable weight because the recitation occurs in

the preamble.   A preamble is generally not accorded any

patentable weight where it merely recites the purpose of a

process or the intended used of a structure, and where the body

of the claim does not depend on the preamble for completeness

but, instead, the process steps or structural limitations are

able to stand alone.   See In re Hirao, 535 f.2D 67, 190 USPQ 15

(CCPA 1976) and Kropa V. Robie, 187 F.2d 150, 152, 88 USPQ 478,

481 (CCPA 1951).   In this particular scenario, the process steps

of claim 1 are able to stand alone without depended on the

preamble for completeness.   With respect to (b), in response to

Applicant's argument that the Examiner's conclusion of

obviousness is based upon improper hindsight reasoning, it must

be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so ling as it takes into account only knowledge which was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Thai whose telephone number is (571)-272-4187. The examiner can normally be reached on from 6:30 A.M. to 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mathew M. Kim can be reached on (571)-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see *http://pair-direct.uspto.gov*. Should you have questions on
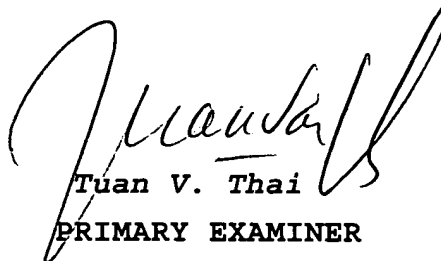
access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

TVT/January 20, 2006

Tuan V. Thai
PRIMARY EXAMINER
Group 2100